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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,031	08/15/2001	Robin U. Roberts	41744	1871

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EXAMINER

PHAM, BRENDA H

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,031

Applicant(s)

ROBERTS ET AL.

Examiner

Brenda Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/03, 5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-33 are pending in this application.

Double Patenting

2. Claims 1-33 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-46 of copending Application No. 09/929,032. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the instant application and copending application claimed a communication network, adapted for use with mobile wireless user terminals. Method and system comprising the same subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 1-14, 19-29 are rejected under 35 USC 112, second paragraph as being lack of antecedent basis in the claim.

claim 1 recites the limitation "said other node" in line 15-16. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "said other node " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 19, line 14 recites the limitation "said other node". There is insufficient antecedent basis for this limitation in the claim.

Claim 20, line 4 and 6, respectively recite the limitation "said other node". There is insufficient antecedent basis for this limitation in the claim.

Claim 30, line 16 recites the limitation "said other node". There is insufficient antecedent basis for this limitation in the claim.

Claim 4, line 2 recites the limitation "said other node". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claim 1, 4, 10, 13, 15, 17, 19, 20, 27, 30-33 are rejected under 35 U.S.C. 102e as being anticipated by La Porta et al (US 6,434,134 B1).

Claims 1, 4, 10, 13, 15, 17, 19, 20, 27, 30-33, La Porta et al discloses a communications network, adapted for use with mobile wireless user terminals, said network comprising (see figure 2):

a packet-switched core network (100); a plurality of access points (BS 5-8) couple to said core network (100), each said access point being adapted to provide any said user terminal (MD 114) with communications access to said core network when said any user terminal becomes affiliated with said access point, and including an address resolution cache (HA) which is adapted to store information representative of affiliation between said user terminals and said access points, and when a said user terminal changes its affiliation from a first said access point to a second said access point, a node on said core network other than said first and second access points is adapted to continue to send data packets intended for receipt by said user terminal to said first access point until having updated its respective address resolution cache based on a message indicating that a said user terminal has changed its affiliation from said first access point to said second access point, and said first access point is adapted to continue to send said data packets received from said other node to said user terminal without sending said data packets to said second access.

Claims 5-6, 23-24, La Porta et al teach wherein said second access point is adapted to issue said message over said core network as an address resolution request

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for an address of said user terminal which has changed its affiliation thereto (column 27, lines 64-67, column 28, lines 1-22).

Claim 8-9, 14, 18, 26, and 29, La Porta et al further teach wherein said access point with which a said user terminal is affiliated is adapted to transmit a received data packet to said user terminal via a wireless communication link (MD communicate with base station, see figure 17).

Claim 7, 25, La Porta et al teach wherein said address of said user terminal includes an Internet protocol address assigned to said user terminal (column 16, lines 25-41, figure 11).

Claims 11-12, 16, 28, La Porta et al further teach an IP gateway router including a respective an address resolution cache which is adapted to store information representative of affiliation between said user terminals and said access points and is updateable based on said message (column 18, lines 51-67).

Allowable Subject Matter

7. Claims 2-3 and 21-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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8. The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record does not teach or fairly suggests in combination wherein when said user terminal changes its affiliation from a first said access point to a second said access point, controlling an additional node other than said first and second access points and said other node to send data packets intended for receipt by said user terminal to said second access point after having updated its respective address resolution cache based on said message while said other node continues to send data packets intended for said user terminal to said first access point which continues to send said data packets received from said other node to said user terminal without sending said data packets to said second access point.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (571) 272-3135. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

September 26, 2005

Brenda Pham

